

**REMARKS**

Claims 8-11, 13, 17-22, 24, and 25 are pending in the application. Applicants note with appreciation the allowance of claims 8-11, 17-22 and 24. Reconsideration of the application in light of the following remarks is respectfully requested.

**I. REJECTION OF CLAIMS 13 AND 25 UNDER 35 U.S.C. § 103(a)**

Claims 13 and 25 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,644,399 (Hoshiyama). Reconsideration of the rejections is respectfully requested for at least the following reasons.

- *Hoshiyama does not teach an optical indicia device or defect location means movable between a first position wherein the optical indicia device is located in the optical path, and a second position wherein the optical indicia device is located outside the optical path, as recited in claims 13 and 25, and no motivation exists to modify Hoshiyama in accordance with the claimed invention.*

As implicitly admitted in the Office Action of February 11, 2005, Hoshiyama does not teach an optical indicia device or a defect location means that is movable between first and second positions that correspond to being in the optical path and outside the optical path, respectively, as claimed. However, the Office Action asserts that the differences between Hoshiyama and the present invention are obvious (stating: "[p]roviding means to adjust and/or remove the scale plate would have been obvious."). (O.A., 2/11/05, p. 2, section 2, ¶3). Applicants respectfully disagree.

In order to arrive at the present invention, one of ordinary skill in the art must have been motivated to modify Hoshiyama in accordance with the present invention. It is conceded that such motivation may be found in the references themselves, in the nature of the problem to be solved, or in the knowledge generally available to one skilled in the art. MPEP § 2143.01, citing to In re Kotzab, 217 F.3d 1365, 55 USPQ2d 1313 (Fed. Cir. 2000). **Nevertheless, such motivation and the source thereof may not be conclusory, but rather the showing must be clear and particular.** In re

Dembiczak, 175 F.3d 994; 50 USPQ2D 1614 (Fed. Cir. 1999). It is respectfully submitted that upon a proper analysis of the cited art, and application of the appropriate standard enunciated above, pending claims 13 and 25 are non-obvious over the cited art.

Hoshiyama teach a measuring apparatus in Fig. 4, wherein an image sensor unit 3 selectively receives light from one of an article 2 on a table 1, and a scale plate 4A.

***Both the scale plate 4A and the article 2 of Hoshiyama are positionally fixed in differing optical axes***, wherein the image sensor unit 3 is able to receive light therefrom in a selective manner *via* a shutter 8A, 8B and half mirror 6 arrangement. That is, in one instance, the shutter 8A is open and the other shutter 8B closed. In such an arrangement, light from the scale plate 4A is blocked and does not reach the half mirror 6, instead light is received by the image sensor 3 solely from the article 2 through the open shutter 8A. In the second instance, light is received solely from the scale plate 4A *via* an open shutter 8B, while light from the article 2 is blocked by the other shutter 8A being closed. Therefore, as set forth by Hoshiyama, "a predetermined portion of the article 2 and the relevant marks on the scale 4A are selectively detected in accordance with the switch-over of the shutters 8A and 8B by the image sensor unit 3." (Col. 5, lines 17-20).

***In the solution in Fig. 4 of Hoshiyama, the optical indicia device (the scale plate 4A) is fixed in its position, and is not movable from a first position to a second position as claimed.*** There is no teaching or suggestion within Hoshiyama that would motivate one of ordinary skill in the art to modify the reference to make the scale plate 4A movable. Certainly such a modification *could* be performed, and such a modification would not render the apparatus of Hoshiyama inoperable, however, ***whether a modification could be performed is not the proper standard for evaluating whether a modification is appropriate under the U.S. patent law.*** MPEP § 2143.01 (citing In re Mills, 916 F.2d 680 (Fed. Cir. 1990) (holding with respect to a combination of cited art that the art must suggest the desirability of the combination)). Rather, the standard for ascertaining whether a modification is appropriate is whether a

***clear and particular motivation*** may be found in the references themselves, in the nature of the problem to be solved, or in the knowledge generally available to one skilled in the art. The Office Action avers that altering the apparatus of Hoshiyama in accordance with the present invention would simplify construction and reduce cost by eliminating the half mirror and the shutter. ***This evidence, however, is not suggested by the art, but rather constitutes a post-modification rationalization, wherein the modification of Hoshiyama in the Office Action is clearly a hindsight use of the pending claims as a blueprint, which is prohibited.***

Further, the Office Action neglects that in Figs. 2, 3, 5, and 6 of Hoshiyama, the scale plate 4A is positioned in the optical path between the image sensor 3 and the article 2, however, ***in no case did the art even hint that the scale plate 4A could be selectively moved or would be desirable. Rather, in each case, the scale plate 4A is fixed with respect to the article 2.*** Therefore one of ordinary skill in the art would not have been motivated to modify the cited art in accordance with the present invention.

Therefore claims 13 and 25 are non-obvious over the cited art. Accordingly, withdrawal of the rejection is respectfully requested.

### **III. CONCLUSION**

For at least the above reasons, the claims currently under consideration are believed to be in condition for allowance, and notice thereof is respectfully requested.

Should the Examiner feel that a telephone interview would be helpful to facilitate favorable prosecution of the above-identified application, the Examiner is invited to contact the undersigned at the telephone number provided below.

Should any fees be due as a result of the filing of this response, the Commissioner is hereby authorized to charge the Deposit Account Number 50-1733, AMDP458US.

Respectfully submitted,  
ESCHWEILER & ASSOCIATES, LLC

By   
Thomas G. Eschweiler  
Reg. No. 36,981

National City Bank Building  
629 Euclid Avenue, Suite 1210  
Cleveland, Ohio 44114  
(216) 502-0600

CERTIFICATE OF MAILING (37 CFR 1.8a)

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: February 15, 2005 Christine Gillroy  
Christine Gillroy

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